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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,456	08/26/2003	Donald E. Godshaw	04286.00124	5091
22908	7590	08/11/2006	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			LARSON, JUSTIN MATTHEW	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,456

Applicant(s)

GODSHAW ET AL.

Examiner

Justin M. Larson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 11, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "separate access opening" of Applicant's amendment to claim 1 does not appear in the specification. Examiner assumes that this term is intended to clarify that there is no separating wall between the first and second partial bags such that their internal volumes are open to one another, however, this interpretation of the term is not clearly supported in the specification as originally filed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 5-10, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the outside surface of said separate section" in lines 12-13. There is insufficient antecedent basis for this limitation in the claim. An outside surface is associated with the first partial bag in lines 2-3 and the second partial bag in lines 6-7, but is never directly associated to the separate section. Furthermore, in line 10, it is unclear what outside surface "the outside surface" is referring to, that of the first partial bag or that of the second partial bag. Finally, claim 1 recites the limitation "the separate section of said second bag outside surface" in lines 20-

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21. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests that wherever an "outside surface" is referred to, it be referred to as, for example, "the outside surface of said first bag" or "the first bag outside surface".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US 6,305,587 B1).

Miller discloses a foldable luggage bag (Figure 9) comprising, in combination: a first lesser capacity partial bag made from a flexible material (col. 5 lines 52-55) and including an outside surface with a front panel (22) and an open periphery opposite said front panel with a first closed loop peripheral fastening mechanism (zipper 102) extending around the open periphery and a separate access opening (132); and a second flexible partial bag of greater capacity than the first, said second bag formed of flexible material with an outside surface including a lateral side surface (24) formed at least in part by the outside surface of said first bag, said second partial bag including a separate section (126) integrally attached to and extending from the open periphery of the first bag with the first peripheral fastening mechanism maintained on the outside surface to enable forming a bag enclosure comprised of the volume of the first bag and

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the second bag, said second bag further including a second closed loop fastener mechanism (102) on the outside surface of said separate section, said second fastener mechanism having the same length as the first fastening mechanism and also fully attachable along its length to the first fastening mechanism, said second fastener closed loop mechanism encircling a part of the separate section of said second bag outside surface and subtending the front panel of the first partial bag upon the unfolding of said first and second bags whereby the first fastener mechanism and the second fastener mechanism may be connected along their entire closed loop length to enclose a portion of the separate section of the second bag within a volume comprised of the first bag and said part of the second bag encircled by the second fastener mechanism and between the front panel and said encircled part of the separate section of said second bag outside surface.

Regarding the first closed loop peripheral fastening mechanism extending around a separate access opening, looking at Figure 9A, when the second partial bag is in the folded or compact position, the access opening (132) is within the compartment that is surrounded by the first closed loop peripheral fastening mechanism (102). Therefore, the first closed loop peripheral fastening mechanism extends around the access opening, effectively satisfying the limitations of the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as applied to claims 1 and 5 above in view of Kepper (US 2,729,257 A).

Regarding claim 6, Miller discloses the claimed invention except the closure mechanism (134) in the side panel (126) of the second partial bag does not provide access to the interior of both the first and second bags, as there is a dividing panel (72) separating the volumes of each bag. Through access opening (132), a user can only access the contents of the second bag.

Kepper, however, teaches that when a convertible bag comprises a second bag (6) being pulled from a first bag (1), the panel separating the respective volumes of the first and second bags may be detachable, allowing a user to access both of the bags' interiors through a single opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the luggage bag of Miller by making wall (72) detachable, as taught by Kepper, in order to allow a user to store larger objects, objects that would otherwise be too large to store within the volume of a single bag, in a combination of the both of the bags' volumes, increasing the utility of the luggage bag.

Regarding claims 7 and 8, the modified Miller bag includes first and second spaced adjustable back straps (120) attached to the back panel.

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Regarding claims 9 and 10, the modified Miller bag includes an access mechanism (zipper 100) in the first partial bag.

Regarding claim 14, the first partial bag of the modified Miller bag is positioned intermediate the top and bottom of the second partial bag.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Miller luggage bag of paragraph #7 above in view of Bendersky (US 5,255,834 A).

The modified Miller luggage bag includes the claimed features except for there being a display on the outside surface of the first bag. Bendersky, however, teaches that it is old and well known in the art to provide displays on the outside of bags/packs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an image or display on the outside of the first bag, as taught by Bendersky, in order to provide an aesthetically appealing bag/pack to suit various consumer tastes.

Response to Arguments

9. Applicant's arguments filed 6/30/06 with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML
8/1/06


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER